

U.S. Patent Application No. 09/932,789
Attorney Docket No. 13 DV 13929 (07783-0077)

REMARKS

The Office Action mailed December 27, 2004 has been received and carefully considered. Reconsideration of the Application is respectfully requested in view of the following remarks. Upon entry of the present amendments, claims 1-5, 7-13, and 15-20 will be pending. As of the Office Action, claims 1-4 and 8-12 stand rejected under 35 U.S.C. §102(e) as anticipated by U.S. Patent 6,810,383 to Loveland (Loveland). Claims 5-6, 13-14, and 16-19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Loveland. Claims 7, 15 and 20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Loveland in view of U.S. Patent 6,581,040 to Wright et al. (Wright).

I. Amendments to the Claims.

Claims 1, 5, 8, 9 and 20 are amended. Claims 6 and 14 are cancelled without prejudice. Support for the amendments is found throughout the specification as originally filed. No new matter is presented.

II. Claim Objections.

Claim 5 is objected to based on a typographical error. Claim 5 has been amended in a manner believed to overcome the objection.

III. Rejection under 35 U.S.C. §102(e).

Claims 1-4 and 8-12 stand rejected under 35 U.S.C. §102(e) as anticipated by Loveland, of which claims 1 and 9 are independent. Applicants respectfully traverse the rejection.

Claim 1 is directed to a method of providing a statement of work to an external source comprising the steps of creating an initial statement of work in a predetermined format, the predetermined format of the initial statement of work having a plurality of sections; associating a project for completion by the external source with the initial statement of work; entering

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information into at least one section of the plurality of sections of the initial statement of work to generate a project statement of work; the information entered into the initial statement of work pertaining to the project associated with the initial statement of work; storing the project statement of work in a database; auditing the project statement of work; transmitting a link to the external source having a location of the project statement of work in the database; and accessing, by the external source, the project statement of work with the transmitted link, wherein the step of auditing the project statement of work further comprises the steps of checking for authority to transmit the link having the location of the project statement of work to the external source; checking for inclusion of appropriate project financial information; checking for compliance of the statement of work with export and intellectual property controls; and summarizing, in a report, entry of information into each section of the plurality of sections.

Claim 9 is directed to a computer program product comprising computer instructions for executing those same steps.

Loveland is directed to a method and apparatus for electronically managing the assignment of tasks to be completed. A party accesses and fills out web-based forms to input information, such as claims information for an insurance claim. The information is automatically compiled and analyzed so that the claims may be processed. Task or claim information may be text based, graphical, audible or in other formats. Task or claim information may be augmented by internal files or databases of embodiments of the present invention which may contain task requestor data. When task information is sufficiently complete, the task may be automatically assigned to a service provider, such as a building contractor hired to repair fire damage on an insured residence. The service provider is notified automatically via telephone.

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cell phone, e-mail or other communications media of the assignment. See Loveland, col. 2, lines 8-54.

At the very least, Loveland fails to teach transmitting a link to an external source having a location of the project work statement in a database as found in Applicants' claimed invention. At most, Loveland teaches notifying a service provider of an assignment by a variety of methods, including telephone, cellular phone, pager, email and radio. Loveland, col. 3, lines 2-8. Loveland does not, however, teach what is transmitted in the notification or how the service provider accesses information relating to the assignment. In fact, not only does Loveland not teach transmitting a link, but several of the preferred methods of notification taught by Loveland, such as by radio or a pager for example, would not even support this type of transmission.

If the Examiner intends to continue to rely on Loveland as a reference, the Examiner is requested to identify the specific passages in Loveland that teach or suggest the limitation of transmitting a link to an external source having a location of the project work statement found in a database. When making a rejection under 35 U.S.C. §103, the Examiner should set forth in the Office Action: (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate, (B) the difference or differences in the claim over the applied reference(s), (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification. MPEP 706.02(j). Applicants respectfully submit that the Examiner's generic assessment that Applicants' claim limitations are met somewhere in columns 2 or 3 (See Office Action at page 4) is insufficient to comply with the MPEP. The MPEP states that "[i]t is important for an examiner to properly communicate the basis for a

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rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply." *Id.*

Furthermore, Loveland also fails to teach auditing a statement of work and specifically fails to teach an audit that includes (a) checking for authority to transmit the link having the location of the project statement of work to the external source, (b) checking for inclusion of appropriate project financial information, (c) checking for compliance of the statement of work with export and intellectual property controls and (d) summarizing, in a report, entry of information into each section of the plurality of sections, as are all found in Applicants' claimed invention.

Again, if the Examiner intends to continue to rely on Loveland as a reference, the Examiner is requested to identify the specific passages in Loveland that teach or suggest the limitation of auditing a statement of work.

With respect to auditing generally, not only does Loveland fail to teach any form of auditing, but Loveland teaches away from auditing in that "when task information is sufficiently complete, the task may be automatically assigned to a service provider." Loveland, col. 2, lines 30-31. *See also*, Office Action at page 10, lines 1-4. If a task is automatically assigned to a service provider as soon as information "sufficiently complete," then there appears to be no opportunity for Loveland's system to conduct an audit.

With respect to checking for authority to transmit the link, as already discussed, Loveland fails to teach, disclose or suggest sending a link, much less checking for authority to send the link.

With respect to checking for inclusion of appropriate project financial information, Loveland merely indicates that estimates provided by service providers can be made available to

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a financially responsible party to make a decision as to whether to accept the estimate.

Loveland, col. 15, lines 6-21. This differs from an audit conducted to check financial information on a project before it is provided to the external source, as found in Applicants' claimed invention.

With respect to checking for compliance of the statement of work with export and intellectual property controls, the Examiner admits that this limitation, incorporated into claims 1 and 9 from claims 6 and 14 respectively, is not taught by Loveland. However, the Examiner opines that it would have been obvious to one of ordinary skill in the art to implement a compliance check with export and intellectual property controls because it would help identify issues related to service provider selection. This argument is inapposite because the checking is with respect to the compliance of the information to be distributed to the external source. Thus, the primary importance of a compliance check of the statement of work relating to export and intellectual property controls relates to the information itself, independent from the process of selecting the external source. In fact, a large part of ensuring that export controls are met depends upon the location of the external source. That is, in many cases one could not even know what export controls to include in the audit until the external source had already been selected, and thus, would not help identify issues in the initial selection of the external source.

With respect to summarizing, in a report, entry of information into each section of the plurality of sections, there is no teaching that each section of Loveland's web-based form is summarized. At most, the system of Loveland performs a generically described analysis that generates a report to help a user of Loveland's system analyze and predict trends within the industry. Thus, Loveland's reports are based on the totality of information stored within

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Loveland's databases, and are not summaries specific to each statement of work generated as part of an auditing process.

Claims 2-4, 8 and 10-12, which are also assertedly anticipated by Loveland, depend from either claim 1 or 9, both shown above to be allowable. For at least these reasons, claims 2-4, 8 and 10-12 are also in condition for allowance. Furthermore, with respect to claims 2 and 10, Loveland fails to teach attaching a file to a corresponding section of the plurality of sections. At most, Loveland teaches that task or claim information in web-based forms may be augmented by internal files or databases. Loveland, col. 2, lines 23-25. However, Loveland does not teach, disclose or suggest that files be attached to a corresponding section of a statement of work and that the information in the attached file corresponds to the section to which it is attached.

With respect to claims 3 and 11, Loveland fails to teach storing a statement of work package in a database. Loveland teaches throughout that various information may be stored in databases, see, e.g. Loveland, col. 6, lines 28-30. Yet, Loveland fails to teach, disclose or suggest that a statement of work, an attached file, and technical data are all assembled into and stored as a single statement of work package, such that the entire package can conveniently be accessed by a link transmitted to an external source.

With respect to claims 4 and 12, as previously discussed, Loveland fails to teach transmitting a link or a statement of work package. Therefore, Loveland cannot teach further limitations on accessing a statement of work transmitted by a link, as found in claims 4 and 12.

With respect to claim 8, there is no description in Loveland of a blanket statement of work, nor has the Examiner addressed this point in the rejection. Furthermore, there is no direct teaching with respect to any task that includes adding a time estimate. At most, the portion of col. 3 of Loveland relied upon by the Examiner in making the rejection teaches that the amount

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of time actually taken by a service provider to respond and/or complete a task is noted as an aspect of evaluating service provider quality.

Accordingly, as Loveland does not teach, disclose or suggest each and every element of Applicants' claimed invention as found in any of claims 1-4 and 8-12, Loveland does not anticipate the claimed invention and the rejection should be withdrawn.

IV. Rejection under 35 U.S.C. § 103(a).

Claims 5-6, 13-14 and 16-19 stand rejected as unpatentable under 35 U.S.C. § 103(a) over Loveland. Claims 7, 15 and 20 stand rejected as assertedly unpatentable under 35 U.S.C. § 103(a) over Loveland in view of Wright. Applicants respectfully traverse the rejections.

Claims 5 and 13 depend from claims 1 and 9 respectively. The limitations of claims 6 and 14 have been incorporated into claims 1 and 9 and these claims have therefore been cancelled. As claims 1 and 9 have already been shown above to be allowable, claims 5 and 13 are also in condition for allowance.

Claim 16 is directed to a system for providing a statement of work to an external source. The system comprises a server computer, the server computer comprising a storage device and a processor; a statement of work application to provide a statement of work for a project to an external source, the statement of work application being stored in the storage device of the server computer, the statement of work application further comprising: a database, the database storing information pertaining to the project and the statement of work; a statement of work template having a predetermined format, the predetermined format of the statement of work template having a plurality of fields, the statement of work template being configured for entry of information into a statement of work for a project; a submission wizard to evaluate a statement of work for completeness and to provide a statement of work to the external source; and a technical

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data wizard to designate technical data associated with a statement of work; and at least one client computer in communication with said server computer, said statement of work application being accessible on said at least one client computer.

The Examiner admits that Loveland fails to teach a submission wizard, but argues that it would have been obvious to one of ordinary skill in the art that Loveland's transmittal to a service provider would have a mechanism to recognize that the task had been completed and thus suggests that there is a means to recognize that the task information entered into the form has been completed. *See* Office Action at page 9.

At the very least, Loveland fails to teach, disclose or suggest a technical data wizard to designate technical data associated with a statement of work. The Examiner appears to rely upon Loveland's teachings that tasks related to different types of information can be defined for a specific project type and that this information might include technical data because certain projects described by Loveland involve construction contractors and the insurance industry. *Id.* Even if Loveland's reference to assigning construction or insurance related tasks was sufficient to overcome the Examiner's mere conjecture that such task information might possibly contain technical data, nothing in Loveland is described or suggested in the way of a "wizard" or routine to associate that technical data with a statement of work. Furthermore, the Examiner has cited no supporting references offering any rationale why the limitations not taught by Loveland would be obvious to one of ordinary skill in the art. Rather, it appears that the Examiner has engaged in impermissible hindsight, in that the only teaching or suggestion of Applicants' claimed invention is found in Applicants' own disclosure.

Claims 17-19 depend from claim 16 and for at least the reasons stated above, are also in condition for allowance.

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Claims 7, 15 and 20 stand rejected as assertedly unpatentable under 35 U.S.C. §103(a) over Loveland in view of Wright, which is directed to a project specific communication system.

Claims 7, 15 and 20 depend from claims 1, 9 and 16 respectively, which have been shown above to be in condition for allowance. Thus, claims 7, 15 and 20 are also in condition for allowance.

Wright does not teach, disclose or suggest the limitations missing from Loveland. Therefore, as Loveland alone, nor in combination with Wright, teaches, discloses, or suggests every element of claims 5, 7, 13, and 15-20, a *prima facie* case of obviousness has not been presented and the rejection should be withdrawn.

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CONCLUSION

Accordingly, for at least these reasons, Applicants respectfully request that the Application be allowed and passed to issue. In the event any outstanding issues remain, Applicants would appreciate the courtesy of a telephone call to Applicants' undersigned representative to resolve such issues in an expeditious manner.

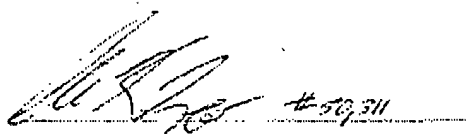
This Amendment/Response has been filed within three months of the mailing date of the Office Action and it is believed that no fees are due with the filing of this paper. In the event that Applicants are mistaken in their calculations, the Commissioner is authorized to deduct any fees determined by the Patent Office to be due from the undersigned's Deposit Account No. 50-1059.

Date: March 23, 2005

Respectfully submitted,

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By:

A handwritten signature in dark ink, appearing to read 'Shawn K. Leppo', is written over a horizontal line. To the right of the signature, the number '50,311' is handwritten.

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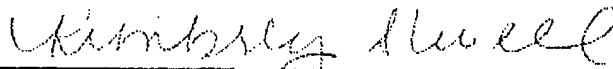
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